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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,744	08/20/2001	Martin Hammarstrom	203517US2PCT	5157

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EXAMINER

KIM, JUNG W

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/786,744	Applicant(s) HAMMARSTROM ET AL.	
	Examiner Jung W Kim	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2001</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-20 are pending.
2. Applicant's preliminary amendment filed August 20, 2001 has been entered.
Claims 3-7, 11, 12, 15, 17-20 are amended.

Claim Objections

3. Claims 1 and 18 are objected to because of the following informalities: claim 1: replace "said first IC-breaker is adapted to from the IP network equipment receive IP data packets" in lines 11-12 with "said first IC-breaker is adapted to receive IP data packets from the IP network equipment"; claim 18: replace "an IP packets" in line 4 with "IP packets". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The term "occasionally" in claim 1 is a relative term which renders the claim indefinite. The term "occasionally" is not defined by the claim, the specification does not

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provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The step of opening the firewall is render indefinite by the use of the term.

7. Claims 1, 2, 4-16 and 19 include limitations defined within parentheses, such as "(IP-NET)" and "(LAN)", however it is not clear if and how these limitations define the claimed invention.

8. The term "limited period of time" in claims 3, 8, 10, 14 and 15, and "temporarily" in claims 13 and 16 are relative terms which render the claims indefinite. The terms "limited period of time" and "temporarily" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The duration of time IP-communication is open through the firewall is rendered indefinite by the use of the terms.

9. Accordingly, claims 3, 17, 18 and 20 are rejected under 112, second paragraph as being dependent on the aforementioned rejected base claims under 112, second paragraph.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 3, 4, 6, 8, 11 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Crichton et al. U.S. Patent No. 6,104,716 (hereinafter Crichton).

12. As per claim 1, Crichton discloses a transmission system, adapted for the transmission of IP data packets, the system including an IP-network and a network protected by a firewall, the firewall being adapted to block incoming traffic to the protected network, and devices to open the firewall to enable IP data packets to be transferred through the firewall to the protected network (fig. 10 and related text),

characterized in, that the devices to open the firewall include a first IC-breaker located on the IP-network side of the firewall and a second IC-breaker located on the protected network side of the firewall (fig. 10, reference nos. 26, 213, 223), that the firewall is transparent to a particular type of IP packets to enable communication between the IC-breakers through the firewall using the particular IP packets, and that the first IC-breaker is adapted to from the IP network equipment receive IP data packets, intended for the protected network, and that the first IC-breaker is adapted to, on receipt of such a particular IP data packet for the protected network, send the particular IP packet to the second IC-breaker, and besides an IP packet of the particular type, returned by the second IC-breaker to the first IC-breaker, opens the firewall, at which the first IC-breaker is adapted to, on receipt of a returned IP packet of the particular type, send the received IP data packet through the open firewall to the second IC-breaker, and that the second IC-breaker is adapted, on receipt of the IP data packet, to send the received IP data packet to the protected network (col. 1:47-58: 9:13-28; two operations are defined for the SOCKS protocol: CONNECT [requesting a connection with the application server] and BIND [establishing an inbound connection after a CONNECT request] both are IP packet requests which enable transparent access across a firewall). The aforementioned cover the limitations of claim 1.

13. As per claims 3, 4 and 6, the rejection of claim 1 under 35 U.S.C. 102(e) is incorporated herein. In addition, the firewall is adapted to be transparent to IP-communication through the firewall from the inside to the outside thereof, and for a

limited period of time, open to IP-communication through the firewall from the outside to the inside thereof (fig. 7, ref. nos. 701 and 714 and related text); the first IC-breaker is adapted, on receipt of an IP data packet, to store the IP data packet and send the stored IP data packet through the open firewall to the second IC-breaker, when the firewall has been opened (fig. 10, ref. nos. 26, 213, 223; server proxies necessarily temporarily stores IP data packets forwarded and received through a firewall); the protected network is a LAN (fig. 10, "INTRANET1" and related text). The aforementioned cover the limitations of claims 3, 4 and 6.

14. As per claims 8 and 11, they are claims corresponding to claims 1, 3, 4 and 6, and they do not teach or define above the information claimed in claims 1, 3, 4 and 6. Therefore, claims 8 and 11 are rejected as being anticipated by Crichton for the same reasons set forth in the rejections of claims 1, 3, 4 and 6.

15. As per claim 20, the rejection of claim 1 under 35 U.S.C. 102(e) is incorporated herein. In addition, the transmission system is a part of a communications system. Col. 2:52-55.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 2, 9, 13, 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crichton in view of Compliment et al. U.S. Patent No. 5,909,549 (hereinafter Compliment) and Mayes et al. U.S. Patent No. 5,793,763 (hereinafter Mayes).

19. As per claim 2, the rejection of claim 1 under 35 U.S.C. 102(e) is incorporated herein. Crichton does not teach the particular type of IP packet to be a ping packet. Compliment discloses the use of ping packets to communicate, reinitiate and maintain connections between a management device and a network device. Compliment, col. 6:41-67. Additionally, Mayes discloses maintaining ICMP packet transparency, specifically ping packets, over a firewall, to maintain basic network messaging. Mayes, Abstract; Figure 5 and related text. Hence, it would be obvious to one of ordinary skill in

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the art at the time the invention was made for the particular type of IP packet to be a ping packet since the transparency of certain Internet messaging packets, such as a ping packet, to a firewall enables unrestricted communication between two devices separated by the firewall by means of the certain ICMP packets. Mayes, *ibid*. The aforementioned cover the limitations of claim 2.

20. As per claim 9, it is a claim corresponding to claims 1-4, 6 and 8, and it does not teach or define above the information claimed in claims 1-4, 6 and 8. Therefore, claim 9 is rejected as being rejected over Crichton in view of Compliment and Mayes for the same reasons set forth in the rejections of claims 1-4, 6 and 8.

21. As per claims 13, 14 and 16-19, they are claims corresponding to claims 1-4, 6, and 20, and it does not teach or define above the information claimed in claims 1-4, 6 and 20. Therefore, claims 13, 14 and 16-19 are rejected as being rejected over Crichton in view of Compliment and Mayes for the same reasons set forth in the rejections of claims 1-4, 6 and 20.

22. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crichton in view of Halsall Data Communications, Computer Networks and Open Systems Chapter 10 "Broadband Multi-service Networks" (hereinafter Halsall).

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23. As per claim 7, the rejection of claim 1 under 35 U.S.C. 102(e) is incorporated herein. Crichton does not expressly disclose the system is an ATM network, adapted for the transmission of IP data packets. Halsall discloses ATM networks as a hybrid network that can transmit a plurality of media types by implementing a single cell size. Crichton, pg. 568, section 10.3 "Cell-based networks". It would be obvious to one of ordinary skill in the art at the time the invention was made for the transmission system to be an ATM network since it enables efficient transport of both normally transmitted data (email), which are switched by means of variable length frames, and time sensitive data (digitized voice; video streaming), which are switched by priority time designations, both are common types of services handled between two companies connected by a network. Halsall, pg. 568, 3rd full paragraph; Crichton, fig. 10.

24. As per claim 12, it is a claim corresponding to claims 1, 3, 4, 6 and 7, and it does not teach or define above the information claimed in claims 1, 3, 4, 6 and 7. Therefore, claim 12 is rejected as being rejected over Crichton in view of Halsall for the same reasons set forth in the rejections of claims 1, 3, 4, 6 and 7.

Allowable Subject Matter

25. Claims 5, 10 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See enclosed form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

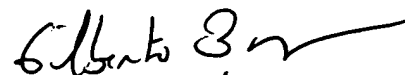
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim
Examiner
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Jk



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March 31, 2005